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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,413	07/07/2006	Giorgio Del Fabro	8455.016.US0000	5858
77213	7590	10/08/2009		
Novak Druce + Quigg, LLP 1300 Eye Street, NW, Suite 1000 Suite 1000, West Tower Washington, DC 20005			EXAMINER ADAMS, GREGORY W	
			ART UNIT 3652	PAPER NUMBER
			MAIL DATE 10/08/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/585,413	<b>Applicant(s)</b> DEL FABRO ET AL.	
	<b>Examiner</b> GREGORY W. ADAMS	<b>Art Unit</b> 3652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/7/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### ***Election/Restrictions***

Applicant's election with traverse of Group I in the reply filed on Sept. 11, 2009 is acknowledged. The traversal is on the ground(s) that the examiner applied the incorrect statute and consequently the incorrect standard. This is found persuasive. Upon review of MPEP 1850 [R-7] there must be a lack of unity of invention beyond the mere discovery of different embodiments and the mere disclosure of a product and a process of using the product are not enough. In this case there is unity of invention as between the different embodiments and as between product as process. See Applicants Sept. 11, 2009 arguments.

The requirement is deemed improper and is therefore withdrawn. Claims 1-21 will be examined without withdrawal of any claims due to restriction. The examiner apologizes for any inconvenience.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "detection means" (claim 15) and the movable housing seatings (claim 16) must be shown or the feature(s) canceled from the claim(s). The drawings shows seatings 30 but how seatings 30 move is not disclosed or described. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

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number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, the claim limitations “first magnetic means” and “second magnetic means” use the phrase “means for”, but they are modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph, because it is not clear if “able to separate...” and “able to pick up...” are intended as limiting since “first magnetic means”

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(which is the equivalent to --first means for magnetizing--) is correct lexicon under the rules established within 35 USC 112, sixth paragraph. For purposes of examination the examiner assumed --first magnetic means for separating from said bundle at least an end segment of a plurality of bars and arranging at least the end segment of said plurality of bars on a plane distanced with respect to said bundle--.

Although the examiner presumed proper means-plus-function nomenclature for purposes of examination, if applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase “means for” or “step for” is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does **not** wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase “means for” or “step for”).

Claim 1, line 6: To what does “it” refer to?

Claim 4, line 2: To what does “they” refer to? See also “them” in claim 18, line 5.

Claim 8, line 2 merely recites “means” without the requisite “for” and associated function (e.g. --means **for correct positioning**--) per USPTO nomenclature as required by 35 USC 112, sixth paragraph. (Emphasis added.).

Claim 8, line 3: The phrase “and/or” renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). See also claims 13 & 14.

With respect to method claims 18-21, the claims provide for the use of first and second magnetic means, but since the claim does not set forth any steps involved in the method it is unclear whether the structure recited is required by the method. Applicant is respectfully reminded that to be entitled to patentable weight in method claims, the structural limitations recited therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. See *Ex parte Pfeiffer*, 135 USPQ 31 (1961). A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced, e.g. it doesn't begin a step with "providing" or "using" or some other **-ing** ending word that provides the active step. (Emphasis added.) For example, claim 18, lines 4-5 recite "first magnetic means are brought near the said bundle in order to magnetically attract an end segment of a plurality of bars and distance them from said bundle" which is not the structural equivalent of --moving a first magnetic means horizontally and vertically to adjacent said bundle; magnetically attracting and gripping with said first magnetic means a plurality of bars; distancing said magnetic means and said gripped plurality of bars from said bundle;-- . Thus, claims 18-21 amount to the mere claiming of a use of a particular structure. For purposes of examination the Examiner assumed proper method claiming format as best understood.

Finally, claims 1-17 are generally narrative and indefinite, failing to conform with current U.S. practice. The claims appear to be a literal translation into English from a foreign document and are replete with idiomatic expressions such as "able to", "associated with" and "in order to".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 11-19 & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miglioranza (US 2003/0202873) in view of Berz (US 4,648,770) and Sartorio (US 5,345,806).

With respect to claim 1, Miglioranza discloses a feeder device comprising:

- first magnetic means 8; and
- second means 17.

Berz discloses transferring bars from a first magnetic means 11a to a second magnetic means 25 which picks up said bars from first magnetic means 11a. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was

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made to modify the apparatus of Miglioranza to include first and second magnetic means working together to transfer parts therebetween, as per the teachings of Berz, as is well known in the art of automatic machinery used to handle steel studding, fence posts, angle irons, and channel. And, Sartorio discloses a second means 50 which is able to pick up from a first means 60 (FIG. 4) an article for loading into a machine. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Miglioranza to include a second means which picks up from a first means, as per the teachings of Sartorio, which "allows the maximum use to be made of the productive capacity." C1. And, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berz in view of the combination of Miglioranza and Sartorio where the predictable result of automatic transfer between articles is achieved.

Claims 4-5, 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miglioranza in view of Berz and Sartorio and further in view of Gepfert (US 5,387,072). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Miglioranza to include a stop element 250, 256 along a second means return travel, as per the teachings of Gepfert, as is well known in bar feeder devices to prevent an article 11 from moving toward fork assembly 13.

Claims 10 & 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miglioranza in view of Berz and Sartorio and further in view of Del Fabro (US 4,732,066). Therefore, it would have been obvious to one having ordinary skill in the art



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at the time the invention was made to modify the apparatus of Miglioranza to include a header element 36, as per the teachings of Del Fabro, where the “shortcomings to be found in known machines lie in the fact that the withdrawal of bars from their bundle takes place in a substantially haphazard manner, and therefore the heads of the bars are not aligned. This entails the need to perform a first facing shearing operation so as to obtain alignment, with a resulting loss of time and waste of material.”

***Allowable Subject Matter***

Claims 6 & 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY W. ADAMS whose telephone number is (571)272-8101. The examiner can normally be reached on M-Th, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saul Rodriguez can be reached on (571) 272-7097. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory W Adams/  
Primary Examiner, Art Unit 3652